

Application No. 09/359,809  
Amendment dated June 10, 2004  
Response to May 14, 2004 Office communication

### **REMARKS/ARGUMENTS**

Applicant has canceled claims 1-72 without prejudice or disclaimer and has added claims 73-91 in place of canceled claims 1 and 57-72. New claims 73-75, 79, and 86-89 correspond to rejected claims 1, 57, 58, 62, and 69-72 (now canceled). New claim 73 comprises a process for making a dispersion comprising a superabsorbent polymer and a material for decreasing friction, whereas new claims 74-75, 78, 79, and 86-89 comprise a composition which is a product produced by this process.

Canceled claims 1, 57, 58, 62, and 69-72 did not specifically relate to a dispersion, and claimed the lubricant as a material for decreasing friction between moving surfaces. The application supports the dispersions of the new claims (claims 73-75, 78, 79, and 86-89) in the penultimate paragraph on page 22. New claims 76, 77, and 80-85, which applicant has not confined to dispersions, relate to mixtures comprising a superabsorbent polymer and a material for decreasing friction, and parallel canceled claims 59, 60, and 63-68.

New claims 77 and 83 add cadmium oxide and lead monoxide to the solid inorganic lubricants of canceled claims 60 and 66. The application supports these lubricants on page 16, last two paragraphs. New claim 85 adds tricresyl phosphate to the phosphates claimed in former claim 68. The application supports tricresyl phosphate at page 11. New multiple dependent claim 91 specifies the lubricant

Application No. 09/359,809  
Amendment dated June 10, 2004  
Response to May 14, 2004 Office communication

additives or mixtures thereof. The specification supports mixtures of additives at page 33 first full paragraph and the paragraph bridging pages 33 and 34.

**The Rejections Under 35 U.S.C. § 102, Second Paragraph and  
Obviousness-Type Double Patenting**

The May 14, 2004 Office communication withdraws the previous rejection under 35 U.S.C. § 102 but maintains the obviousness-type double patenting rejection over Serial No. 09/357,957, filed July 21, 1999. The present examiner allowed application Serial No. 09/357,957, and applicant paid the issue fee. Accordingly, applicant submits a Terminal Disclaimer with this amendment to overcome the obviousness-type double patenting rejection.

**The Rejections Under 35 U.S.C. § 112, Second Paragraph**

Applicant submits that the present amendment addresses the various rejections of the claims under 35 U.S.C. § 112 second paragraph. New claims 76 and 77, dependent on claim 74 correspond to canceled claims 59 and 60 dependent on canceled claim 57 which the examiner rejected because independent claim 57 did not support "carbon or metal" in the dependent claims. New independent claim 74 refers generically to a "material for decreasing friction," whereas new dependent claim 76

Application No. 09/359,809  
Amendment dated June 10, 2004  
Response to May 14, 2004 Office communication

describes this material subgenerically as "carbon or metal." New dependent claim 77 further describes these carbon materials and metals.

The generic description of a "material for decreasing friction" in new independent claim 74 also supports the new dependent claim 81 "oil or greases thereof and water, optionally containing a lubricant additive." Claim 81 tracks canceled claim 64 which the examiner rejected for lack of antecedent support for the terminology "oil or greases thereof and water, optionally containing a lubricant additive." Claim 74 also supports the lubricants of new dependent claims 82 and 83 (the latter tracking rejected claims 65 and 66, now canceled) for substantially the same reasons.

#### **The Rejections Under 35 U.S.C. § 103(a)**

The examiner rejects claims 1, 57, 58, 62, 69, 70, 71, and 72 under 35 U.S.C. § 103(a) as unpatentable over Freeman, United States Patent 5, 218, 011 in view of Le-Khac, United States Patent No. 4,616,063. Applicant traverses the rejection and requests further consideration and reexamination.

As noted above Claims 73-75, 79, and 86-89 (corresponding to rejected claims 1, 57, 58, 62, 69, 70, 71, and 72, now canceled) claim the invention as a process for making a dispersion comprising a superabsorbent polymer and a material for decreasing friction (claim 73) and a product-by-process composition which is a

Application No. 09/359,809  
Amendment dated June 10, 2004  
Response to May 14, 2004 Office communication

dispersion produced by this process (claims 74-75, 79, and 86-89). Neither Freeman nor Le-Kach teach or suggest dispersions of materials for decreasing friction and a superabsorbent polymer. The Patent and Trademark Office has allowed claims of this type in a similar application of Rebouillat et al. filed more than one year after the filing date of the present application.<sup>1</sup>

### **CONCLUSIONS**

Applicant requests the Examiner to withdraw the rejections in view of the foregoing amendments and remarks and pass the application to issue .

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

Dated: June 10, 2004

By:   
Robert J. Eichelburg Reg. No. 23,050

### **CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

I hereby certify that this correspondence is being deposited with the United States

---

1. Cf. Rebouillat et al., Ser. No. 10/317,575 filed 12/12/02; Notice of Allowance 3/18/04; Issue Fee paid 4/12/04; Electronic Publication No. 20030124350.

Application No. 09/359,809  
Amendment dated June 10, 2004  
Response to May 14, 2004 Office communication

Postal Services under 37 C.F.R. § 1.8 on the date indicated below and is addressed to  
the Commissioner for Patents, P.O. BOX 1450, Alexandria, Virginia 22313 -1450

Dated: June 10, 2004

By:   
Robert J. Eichelburg, Reg. No 23,057